

BRIEF ON APPEAL

Applicant: Jurgen Reinold et al.  
Docket No.: MCG00215  
Serial No.: 09/071,046  
File Date: May 4, 1998

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Art Unit: 2611

Examiner: Krista Bui

Title: METHOD AND SYSTEM FOR DISTRIBUTING DIGITAL AUDIO  
AND VIDEO TO AN ANALOG WIRELINE DEVICE



DISTRIBUTING DIGITAL AUDIO  
WIRELINE DEVICE

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- 1 page Transmittal Form
  - 2 page Fee Transmittal submitted in duplicate
  - 16 pages Brief on Appeal submitted in triplicate
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KDW/lw

Mailed March 19, 2003

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Enclosed:

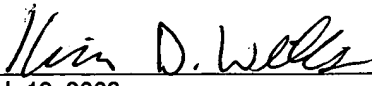
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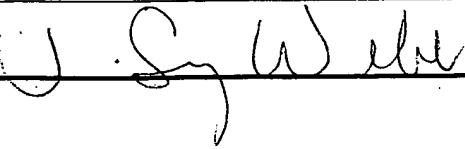
KDW/lw

Mailed March 19, 2003

<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)		Application Number	09/071,046
		Filing Date	May 4, 1998
		First Named Inventor	Jurgen Reinold
		Group Art Unit	2611
		Examiner Name	Krista Bui
Total Number of Pages in this Submission	51	Attorney Docket Number	MCG00215

ENCLOSURES		(check all that apply)
<input checked="" type="checkbox"/> Fee Transmittal Form  <input type="checkbox"/> Fee Attached  <input type="checkbox"/> Amendment/Reply  <input type="checkbox"/> After Final  <input type="checkbox"/> Affidavits/Declaration(s)  <input type="checkbox"/> Extension of time Request  <input type="checkbox"/> Express Abandonment Request  <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Documents  <input type="checkbox"/> Response to Missing Parts/ Incomplete Application  <input type="checkbox"/> Response to Missing Parts Under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application)  <input type="checkbox"/> Drawing(s)  <input type="checkbox"/> Licensing-Related papers  <input type="checkbox"/> Petition  <input type="checkbox"/> Petition to Convert to a Provisional Application  <input type="checkbox"/> Power of Attorney, Revocation, Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number of CDs	<input type="checkbox"/> After Allowance Communication to Group  <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences  <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)  <input type="checkbox"/> Proprietary Information  <input type="checkbox"/> Status Letter with appropriate copies  <input type="checkbox"/> Other Enclosure(s) (please identify below) <div style="margin-left: 20px;"> <input type="checkbox"/> Response to Restriction Requirement  <input type="checkbox"/> Associate Power of Attorney  <input type="checkbox"/> RCE  <input type="checkbox"/> Copy of Notice to File Missing Parts  <input type="checkbox"/> Transmittal of Formal Drawings         </div>
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm or Individual	Kevin D. Wills	Registration No.	43,993
Signature			
Date	March 19, 2003		

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage thereon, as first-class mail, in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on the date listed below:			
Typed or printed name	V. Lynn Webb		
Signature		Date	March 19, 2003

# FEE TRANSMITTAL

Patent fees are subject to annual revision

Complete if Known

Application Number 09/071,046  
Filing Date May 4, 1998  
First Named Inventor Jurgen Reinold  
Examiner Name Krista Bui  
Group Art Unit 2611  
Attorney Docket No. MCG00215

TOTAL AMOUNT OF PAYMENT (\$ 320.00)

## METHOD OF PAYMENT

1. ☒ The Commissioner is hereby authorized to charge indicated fees and credit any overpayment to:

Deposit Account Number 502117  
Deposit Account Name Motorola, Inc.

☒ Charge Any Additional Fee required under 37 CFR 1.16 and 1.17

☐ Applicant claims small entity status. See 37 CFR 1.27

2. ☐ Payment Enclosed:

☐ Check ☐ Credit Card ☐ Money Order ☐ Other

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
101	740	201	370	Utility filing fee	
106	330	206	165	Design filing fee	
107	510	207	255	Plant filing fee	
108	740	208	370	Reissue filing fee	
114	160	214	80	Provisional filing fee	

SUBTOTAL (1) (\$ 0)

### 2. EXTRA CLAIM FEES

Total Claims	Previously Paid**	Extra Claims	Fee from below	Fee Paid
Independent Claims	20	X	18	
Multiple Dependent	3	X	84	
			280	

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description
103	18	203	9	Claims in excess of 20
102	84	202	42	Independent claims in excess of 3
104	280	204	140	Multiple dependent claim, if not paid
109	84	209	42	* Reissue independent claims over original patent
110	18	210	9	* Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ 0)

\*\*OR NUMBER PREVIOUSLY PAID, IF GREATER THAN STANDARD ALLOWANCE.

\*For Reissues, see above

## SUBMITTED BY

Name (Print/Type) Kevin D. Wills

Signature

*Kevin D. Wills*

Registration No. 43,993

Telephone

602-952-4364

Date

March 19, 2003

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description
105	130	205	65	Surcharge - late filing fee or oath
127	50	227	25	Surcharge - late Provisional filing
139	130	139	130	Non-English specification
147	2520	147	2520	For filing a request for ex parte Reexamination
112	920*	112	920*	Requesting publication of SIR prior to Examiner action
113	1840*	113	1840*	Requesting publication of SIR after Examiner action
115	110	215	55	Extension for reply within first month
116	400	216	200	Extension for reply within second month
117	920	217	460	Extension for reply within third month
118	1440	218	720	Extension for reply within fourth month
128	1960	228	980	Extension for reply within fifth month
119	320	219	160	Notice of Appeal
120	320	220	160	Filing a brief in support of an appeal
121	280	221	140	Request for oral hearing.
138	1510	138	1510	Petition to institute a public use proceeding
140	110	240	55	Petition to revive - unavoidable
141	1280	241	640	Petition to revive - unintentional
142	1280	242	640	Utility issue fee (or reissue)
143	460	243	230	Design issue fee
144	620	244	310	Plant issue fee
122	130	122	130	Petitions to the Commissioner
123	50	123	50	Processing fee under 37 CFR 1.17(q)
126	180	126	180	Submission of IDS
581	40	581	40	Recording each patent assignment per property (times number of properties)
146	740	246	370	Filing a submission after final rejection (37 CFR § 1.129(a))
149	740	249	370	For each additional invention to be examined (37 CFR § 1.129(b))
179	740	279	370	Request for Continued Examination (RCE)
169	900	169	900	Request for expedited examination of a design application

Other fee (specify)

\* Reduced by Basic Filing Fee paid

SUBTOTAL (3) (\$ 320.00)

Complete (if applicable)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: : Date: March 19, 2003  
**Reinold et al.**

Serial No.: 09/071,046 : Group Art Unit: 2611

Filed: May 4, 1998 : Examiner: Bui, Krista

**For: METHOD AND SYSTEM FOR DISTRIBUTING DIGITAL AUDIO AND  
VIDEO TO AN ANALOG WIRELINE DEVICE**

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING  
DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST  
CLASS MAIL IN AN ENVELOPE ADDRESSED TO:  
COMMISSIONER OF PATENTS AND TRADEMARKS  
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Date of Deposit

MOTOROLA INC.

Name of Assignee



SIGNATURE

March 19, 2003

DATE

**BRIEF ON APPEAL**

Honorable Commissioner of Patents and Trademarks,  
Washington, D.C. 20231

SIR:

Please consider the following Brief on Appeal for the above identified patent  
application assigned to Motorola, Inc.

**I. REAL PARTY IN INTEREST**

The subject application is assigned to Motorola, Inc., the real party of interest.

**II. RELATED APPEALS AND INTERFERENCES**

To Appellants' knowledge, there are no related appeals or interferences.

### III. STATUS OF CLAIMS

1. A copy of claims 1-30, the claims on appeal, are provided in Appendix A.
2. Claims 1-5, 9-14, 16-18 and 21-30 stand rejected under 35 U.S.C. 102(e) as being anticipated by Tsumori et al. (U.S. Patent No. 5,650,827).
3. Claims 6, 14 and 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Tsumori et al. (U.S. Patent No. 5,650,827) in view of Schein et al. (U.S. Patent No. 6,002,394).
4. Claims 7-8 and 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Tsumori et al. (U.S. Patent No. 5,650,827) in view of Schulhof et al. (U.S. Patent No. 5,841,979).
5. Claim 20 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Tsumori et al. (U.S. Patent No. 5,650,827) in view of Schein et al. (U.S. Patent No. 6,002,394) and Schulhof et al. (U.S. Patent No. 5,841,979).

### IV. STATUS OF AMENDMENTS FILED SUBSEQUENT TO FINAL REJECTION

No response has been mailed subsequent to the final rejection.

### V. SUMMARY OF INVENTION

The present invention is directed to a system and method of distributing audio and/or video content of a digital audio and/or video signal respectively to an analog wireline device (page 3, lines 22-30, FIG.1). An audio input interface (122) receives a digital audio signal from a plurality of sources and identifies an audio bitstream, where the audio bitstream comprises audio data based on a plurality of encoding methods corresponding to the plurality of sources (page 9, lines 5-24). Further, an audio decoding unit decodes the audio bitstream (page 10, lines 19-20), and an audio digital-to-analog converter converts the audio bitstream to an analog audio signal (page 11, lines 1-2).

Thereafter an audio output interface (128) distributes the analog audio signal to an analog wireline device (100) (FIG.5, page 14, lines 1-27).

A video input interface (142) receives a digital video signal from a plurality of sources and identifies a video bitstream, where the video bitstream comprises video data based on a plurality of encoding methods corresponding to the plurality of sources (page 11, line 17 to page 12, line 5). Further, a video decoding unit decodes the video bitstream (page 13, lines 1-2), and a video digital-to-analog converter converts the video bitstream to an analog video signal (page 13, lines 17-18). Thereafter a video output interface (148) distributes the analog video signal to an analog wireline device (100) (FIG.5, page 14, lines 1-27).

## VI. ISSUES

Whether claims 1-5, 9-14, 16-18 and 21-30 are anticipated by Tsumori et al. (U.S. Patent No. 5,650,827) under 35 U.S.C. §102(e). Further, whether claims 6, 14 and 19 are unpatentable over Tsumori et al. (U.S. Patent No. 5,650,827) in view of Schein et al. (U.S. Patent No. 6,002,394) under 35 U.S.C. §103. Further, whether claims 7-8 and 15 are unpatentable over Tsumori et al. (U.S. Patent No. 5,650,827) in view of Schulhof et al. (U.S. Patent No. 5,841,979). Further, whether claim 20 is unpatentable over Tsumori et al. (U.S. Patent No. 5,650,827) in view of Schein et al. (U.S. Patent No. 6,002,394) and Schulhof et al. (U.S. Patent No. 5,841,979).

## VII. GROUPING OF CLAIMS

Appellants offer no other grouping of claims.

## VIII. ARGUMENTS

### 35 U.S.C. §102(e)

Claims 1-5, 9-14, 16-18 and 21-30 stand rejected under 35 U.S.C. 102(e) as being anticipated by Tsumori et al. (U.S. Patent No. 5,650,827, hereinafter called Tsumori et al.).

Appellants' independent claims 1, 9, 16, 21, 25 and 29 call for, among other things, *a method for distributing audio/video content of a **digital** audio/video signal to an analog wireline device including an audio/video input interface receiving the **digital** audio/video signal from a **plurality of sources** and identifying an audio/video bitstream, wherein the audio bitstream comprises audio/video data based on a **plurality of encoding methods** corresponding to the plurality of sources.*

"A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently described in a single prior art reference." Verdegall Bros. V. Union Oil Co. Of California, 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989). Contrary to Examiner's assertion that all elements are disclosed in Tsumori et al., Appellants' claimed elements including: *interface receiving the **digital** audio/video signal from a **plurality of sources** and identifying an audio/video bitstream, wherein the audio bitstream comprises audio/video data based on a **plurality of encoding methods** corresponding to the plurality of sources* are not disclosed in Tsumori et al., so the rejection is unsupported by the art and should be withdrawn.

Tsumori et al. discloses a television receiver capable of providing a picture-in-picture display and of displaying contents of manual operations performed for the recording of programs (column 1, lines 7-10). Tsumori et al. goes on to disclose receiving audio and video broadcasts via VHF/UHF and a video tape recorder (VHS), which are both **analog** sources, and therefore cannot produce digital audio/video signals as claimed by Appellants. Tsumori et al. further discloses receiving broadcasts from High Definition Television (HDTV), where HDTV uses MUSE downconversion, a JSB decoder to descramble the signal (where descrambling inherently refers to an analog signal), and a communication satellite (CS) decoder to demodulate the PSK-modulated signal (column 5, lines 14-48). This is all one process to convert an HDTV signal to a signal that conforms to the NTSC standard for viewing on a television (column 5, lines 49-56).

#### **HDTV Is The Only Digital Source Disclosed by Tsumori et al.**

While Appellant's claims call for receiving a digital audio/video signal from a plurality of sources, Tsumori et al. discloses only a single source, HDTV, from which a digital signal is received. The other sources disclosed by Tsumori et al. provide analog signals. Although the Examiner alleges that the "plurality of sources" claimed by



Appellants can be either digital or analog, the claim language clearly and unambiguously states a method of distributing content of a **digital** audio/video signal to an analog wireless device comprising receiving the **digital** audio/video signal from a plurality of sources. The only source disclosed in Tsumori et al. from which a digital audio/video signal is received is HDTV.

Further, it is obvious that a digital audio/video signal will originate from a digital source. If the signal originated from an analog source, there would be no need convert the bitstream to an analog audio/video signal for distribution to an analog wireline device as claimed by Appellants in the independent claims. Therefore, it does not follow that the digital signal can come from mixed sources whether analog or digital as alleged by the Examiner.

#### **HDTV Is Only A Single Digital Source**

The HDTV source disclosed in Tsumori et al., while digital, is only one type of source, not a plurality of sources. While the HDTV source may have more than one channel available, the HDTV from which the signal originates is still only a single source.

#### **HDTV Employs Only A Single Encoding Method**

Even if the HDTV signal were to be considered more than one source as alleged by the Examiner, the HDTV source disclosed by Tsumori et al. uses only one type of encoding method, **not** a plurality of encoding methods as claimed by Appellants. The Examiner cites CS decoding, JSB decoding and MUSE converter as different encoding/decoding techniques, while in reality these are individual process steps in downconverting and decoding an HDTV signal, which is a single source encoded in an encoding methodology for HDTV signals. Therefore, MUSE, JSB and CS do not provide the use of different encoding/decoding methods to handle different encoding formats from different sources. They are simply individual steps designed specifically to process an HDTV signal. Since the HDTV is only one source with one encoding method, it certainly does not provide the claimed limitation of a **digital audio/video signal from a plurality of sources** or the claimed limitation of **audio/video data based on a plurality of encoding methods corresponding to a plurality of sources**.

Since Tsumori et al. does not disclose or teach the claimed limitations of an **interface receiving the digital audio/video signal from a plurality of sources and identifying an audio/video bitstream, wherein the audio bitstream comprises audio/video data based on a plurality of encoding methods corresponding to the plurality of sources**,

Tsumori et al. cannot anticipate Appellants' independent claims 1, 9, 16, 21, 25 and 29. Therefore, Appellants' respectfully submit that the rejection is improper and should be withdrawn.

### **35 U.S.C. §103**

Claims 6, 14 and 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Tsumori et al. (U.S. Patent No. 5,650,827) in view of Schein et al. (U.S. Patent No. 6,002,394, hereinafter called Schein et al.).

Claims 7-8 and 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Tsumori et al. (U.S. Patent No. 5,650,827) in view of Schulhof et al. (U.S. Patent No. 5,841,979, hereinafter called Schulhof et al.).

Claim 20 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Tsumori et al. (U.S. Patent No. 5,650,827) in view of Schein et al. (U.S. Patent No. 6,002,394) and Schulhof et al. (U.S. Patent No. 5,841,979).

It is incumbent upon the Examiner to prove a *prima facie* case of obviousness (MPEP 2143). To establish a *prima facie* case three basic criteria must be met. First, the prior art reference must teach or suggest all the claim limitations. Second, there must be a reasonable expectation of success. Finally, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference.

#### **1 - The combination does not provide Appellants' claimed invention.**

Appellants' independent claims 1, 16, 21 and 29, call for, among other things, *receiving a digital audio signal from a plurality of sources and identifying an audio bitstream comprising audio data based on a plurality of encoding methods corresponding to the plurality of sources*. Appellants' independent claims 9, 16, 25 and 29 call for, among other things, *receiving a digital video signal from a plurality of sources and identifying a video bitstream comprising video data based on a plurality of encoding methods corresponding to the plurality of sources*. The cited references of Tsumori et al, Schein et al. and Schulhof et al. do not teach or suggest these features.

Tsumori et al. discloses a television receiver capable of providing a picture-in-picture display and of displaying contents of manual operations performed for the recording of programs (column1, lines 7-10). Tsumori et al. goes on to disclose receiving audio and video broadcasts via VHF/UHF and a video tape recorder (VHS), which are

both **analog** sources, and therefore cannot produce digital audio/video signals as claimed by Appellants. Tsumori et al. further discloses receiving broadcasts from High Definition Television (HDTV), where HDTV uses MUSE downconversion, a JSB decoder to descramble the signal (where descrambling inherently refers to an analog signal), and a communication satellite (CS) decoder to demodulate the PSK-modulated signal (column 5, lines 14-48). This is all one process to convert an HDTV signal to a signal that conforms to the NTSC standard for viewing on a television (column 5, lines 49-56).

#### HDTV Is The Only Digital Source Disclosed by Tsumori et al.

While Appellant's claims call for receiving a digital audio/video signal from a plurality of sources, Tsumori et al. discloses only a single source, HDTV, from which a digital signal is received. The other sources disclosed by Tsumori et al. provide analog signals. Although the Examiner alleges that the "plurality of sources" claimed by Appellants can be either digital or analog, the claim language clearly and unambiguously states a method of distributing content of a **digital** audio/video signal to an analog wireless device comprising receiving the **digital** audio/video signal from a plurality of sources. The only source disclosed in Tsumori et al. from which a digital audio/video signal is received is HDTV.

Further, it is obvious that a digital audio/video signal will originate from a digital source. If the signal originated from an analog source, there would be no need convert the bitstream to an analog audio/video signal for distribution to an analog wireline device as claimed by Appellants in the independent claims. Therefore, it does not follow that the digital signal can come from mixed sources whether analog or digital as alleged by the Examiner.

#### HDTV Is Only A Single Digital Source

The HDTV source disclosed in Tsumori et al., while digital, is only one type of source, not a plurality of sources. While the HDTV source may have more than one channel available, the HDTV from which the signal originates is still only a single source.

#### HDTV Employs Only A Single Encoding Method

Even if the HDTV signal were to be considered more than one source as alleged by the Examiner, the HDTV source disclosed by Tsumori et al. uses only one type of encoding method, **not** a plurality of encoding methods as claimed by Appellants. The Examiner cites CS decoding, JSB decoding and MUSE converter as different encoding/decoding techniques, while in reality these are individual process steps in

downconverting and decoding an HDTV signal, which is a single source encoded in an encoding methodology for HDTV signals. Therefore, MUSE, JSB and CS do not provide the use of different encoding/decoding methods to handle different encoding formats from different sources. They are simply individual steps designed specifically to process an HDTV signal. Since the HDTV is only one source with one encoding method, it certainly does not provide the claimed limitation of a *digital audio/video signal from a plurality of sources* or the claimed limitation of *audio/video data based on a plurality of encoding methods corresponding to a plurality of sources*.

Schein et al. teaches a method for providing television schedule information to a viewer, and allowing the viewer to interact with schedule information in a remote database (abstract). Schein et al. goes on to teach the incorporation of an interactive computer system to assist a television viewer in utilizing television schedule information and linking with a database to search, retrieve and initiate a subscription to information. Although Schein et al. discloses receiving audio and video signals on a variety of channels (column 2, lines 37-65), Schein et al. does not disclose, teach or suggest anything about a plurality of sources having *data based on a plurality of encoding methods corresponding to the plurality of sources*. In fact, Schein et al. *only* teaches that signals are received as an analog signal using the NTSC standard or as a digital signal modulated into an analog carrier as is well known in the art (column 6, lines 26-45).

Schulhof et al. teaches a portable digital audio playback module for digital audio file receipt and storage, D/A conversion and playback (column 2, line 66 to column 3, line 1). Schulhof et al. is related to the field of enhancing the delivery of audio data and does not teach or suggest the Appellants' claimed invention. In other words, Schulhof et al. does not disclose or teach *receiving a digital audio and/or video signal from a plurality of sources and identifying a bitstream comprising audio and/or video data based on a plurality of encoding methods corresponding to the plurality of sources*.

In the Office Action dated June 4, 2002 (Office Action), the Examiner states second paragraph on page 4 of the Office Action that Schein et al. does not clearly further disclose the step of wherein the audio bit stream comprises audio data based on a plurality of encoding methods corresponding to a plurality of sources. The Examiner further states on page 6 of the Office Action that Schein et al. does not clearly show that the digital video signal is received "from a plurality of sources as amended." The Examiner still further states on page 7 of the Office Action that Schein et al. does not clearly show the

step of wherein the video bit stream comprises video data based on a plurality of encoding methods corresponding to a plurality of sources.

Neither Schein et al. (as acknowledged by the Examiner in the June 4, 2002 Office Action) nor Schulhof et al. make up for the deficiencies in the Tsumori et al. In other words, Schein et al. and Schulhof et al. do not disclose or teach *receiving a digital audio and/or video signal from a plurality of sources and identifying a bitstream comprising audio and/or video data based on a plurality of encoding methods corresponding to the plurality of sources.*

It is respectfully pointed out that the limitation of the receiving a digital audio and/or video signal from a plurality of sources and identifying a bitstream comprising audio and/or video data based on a plurality of encoding methods corresponding to the plurality of sources is not found in the cited art and that functional claim language must be considered in evaluating a claim relative to the prior art. Lewmar Marine, Inc. v. Barent, Inc., 827 F.2d 744 (Fed. Cir. 1987); Raytheon Co. v. Roper Corp., 724 F.2d 951 (Fed. Cir. 1983). The PTO is not permitted to ignore the results and advantages produced by claimed subject matter, of which the prior art is devoid, simply because the claim limitations are similar to that otherwise found in the prior art. Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675 (Fed. Cir. 1988); In re Chupp, 816 F.2d 643 (Fed. Cir. 1987); Fromson v. Advanced Offset Plate, 755 F.2d 1549 (Fed. Cir. 1985); In re Piasecki, 745 F.2d 1468 (Fed. Cir. 1984); Carl Schenck, A.G. v. Nortron Corp., 713 F.2d 782 (Fed. Cir. 1983).

Appellants' respectfully submit that independent claims 1, 9, 16, 21, 25 and 29 as drafted clearly distinguish over the cited art. In particular, Tsumori et al., Schein et al. and Schulhof et al., individually or in combination, do not disclose or teach receiving a digital audio and/or video signal from a plurality of sources and identifying a bitstream comprising audio and/or video data based on a plurality of encoding methods corresponding to the plurality of sources. Tsumori et al., Schein et al. and Schulhof et al., individually or in combination, do not contain at least these features of the Appellants' independent claims 1, 9, 16, 21, 25 and 29, they do not include all of the elements of Appellants' independent claims 1, 9, 16, 21, 25 and 29, and therefore cannot anticipate Appellants' independent claims. Therefore, Appellants' respectfully submit that the rejection is improper and should be withdrawn.

**2 - There is no motivation or suggestion contained in the cited art to combine the teachings of the references.**

Before obviousness may be established, the Office Action *must show specifically* the principle, known to one of ordinary skill that suggests the claimed combination. In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). In other words, the Examiner *must explain* the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention. Id. The factual question of motivation is material to patentability and *cannot be resolved based on subjective belief and unknown authority*. Id. at 1344. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577 (Fed. Cir. 1984). The critical inquiry is whether there is something in the prior art as a whole *to suggest* the desirability, and thus the obviousness, of making the combination. Fromson v. Advance Offset Plate, 755 F.2d 1549, 1556 (Fed. Cir. 1985).

The Examiner asserts that it would have been obvious to combine Tsumori et al., and/or Schein et al. and/or Schulhof et al. to arrive at the Appellants' claimed invention. Appellants' respectfully submit that these statements are unsupported assertions expressing *conclusions* and as such are *not* reasons for rejection under 35 U.S.C. § 103(a). Moreover, the test for obviousness must come from, or at least be compatible with, the requirements of 35 U.S.C. § 103(a), stating that: "... if the differences between the subject matter sought to be patented and the prior art are such that *the subject matter as a whole* would have been obvious ..." (emphasis added; 35 U.S.C. § 103(a)). The Office Action's unsupported assertions at most address obviousness of a *difference* between the claimed subject matter and the prior art, and not obviousness of the *claimed subject matter as a whole*, as required by the plain language of 35 U.S.C. § 103(a). The rejection in question can only be based upon a hindsight reconstruction enlightened by Appellants' own disclosure. As the CAFC stated in W.L. Gore Associates, Inc. v. Garlock, Inc. (220 USPQ 303, 312-13 (Fed. Cir. 1983)):

To imbue one of ordinary skill in the art with knowledge of the invention in suit, where no prior art reference or references of record

convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

The Examiner has failed to show either a suggestion in the art or a compelling motivation based on sound scientific principles to combine the references and therefore the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn. Appellants respectfully submit that there is no suggestion to combine the references, and if they could be properly combined, do not lead to the Appellants' invention.

Claims 2-8 depend either directly or indirectly from claim 1 and are believed to be allowable over the relied on references for at least the same reasons as claim 1.

Claims 10-15 depend either directly or indirectly from claim 9 and are believed to be allowable over the relied on references for at least the same reasons as claim 9.

Claims 17-20 depend either directly or indirectly from claim 16 and are believed to be allowable over the relied on references for at least the same reasons as claim 16.

Claims 22-24 depend either directly or indirectly from claim 21 and are believed to be allowable over the relied on references for at least the same reasons as claim 21.


Claims 26-28 depend either directly or indirectly from claim 25 and are believed to be allowable over the relied on references for at least the same reasons as claim 25.

Claim 30 depends directly from claim 29 and is believed to be allowable over the relied on references for at least the same reasons as claim 29.

Appellants therefore pray for the reversal of the final rejection and the allowance of the subject application.

Respectfully submitted,

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IX. APPENDIX A

1. (Twice Amended) A system for distributing audio content of a digital audio signal to a analog wireline device, comprising:

an audio input interface receiving the digital audio signal from a plurality of sources and identifying an audio bitstream, wherein the audio bitstream comprises audio data based on a plurality of encoding methods corresponding to the plurality of sources;

an audio decoding unit connected to the audio input interface and decoding the audio bitstream;

an audio digital to analog converter connected to the audio decoding unit and converting the audio bitstream to an analog audio signal; and

an audio output interface connected to the audio digital to analog converter and distributing the analog audio signal to the analog wireline device.

2. The system of claim 1, further comprising an audio digital decryption unit connected to the audio input interface and decrypting the audio bitstream.

3. The system of claim 1, further comprising an audio analog decryption unit connected to the audio digital to analog converter and decrypting the analog audio signal.

4. The system of claim 1 wherein the audio output interface distributes the analog audio signal to multiple devices.

5. The system of claim 1 wherein the audio input interface receives the digital audio signal from a network.

6. The system of claim 1 wherein the audio input interface receives the digital audio signal from a local storage device.

7. The system of claim 1 wherein the audio input interface receives the digital audio signal produced by a text-to-speech application.

8. The system of claim 1 wherein the audio input interface receives the digital audio signal produced by a digital musical instrument.



9. (Twice Amended) A system for distributing video content of a digital video signal to a analog wireline device, comprising:

a video input interface receiving the digital video signal from a plurality of sources and identifying a video bitstream, wherein the video bitstream comprises video data based on a plurality of encoding methods corresponding to the plurality of sources;

a video decoding unit connected to the video input interface and decoding the video bitstream;

a video digital to analog converter connected to the video decoding unit and converting the video bitstream to an analog video signal; and

a video output interface connected to the video digital to analog converter and distributing the analog video signal to the analog wireline device.

10. The system of claim 9, further comprising a video digital decryption unit connected to the video input interface and decrypting the video bitstream.

11. The system of claim 9, further comprising a video analog decryption unit connected to the video digital to analog converter and decrypting the analog video signal.

12. The system of claim 9 wherein the video output interface distributes the analog video signal to multiple devices.

13. The system of claim 9 wherein the video input interface receives the digital video signal from a network.

14. The system of claim 9 wherein the video input interface receives the digital video signal from a local storage device.

15. The system of claim 9 wherein the video input interface receives the digital video signal produced by a digital video camera.

16. (Twice Amended) A system for distributing audio and video content of a digital audio signal and a digital video signal to an analog wireline device, comprising:

an audio input interface receiving the digital audio signal from a plurality of sources and identifying an audio bitstream, wherein the audio bitstream comprises audio data based on a plurality of encoding methods corresponding to the plurality of sources;

an audio decoding unit connected to the audio input interface and decoding the audio bitstream;

an audio digital to analog converter connected to the audio decoding unit and converting the audio bitstream to an analog audio signal;

an audio output interface connected to the audio digital to analog converter and distributing the analog audio signal to the analog wireline device;

a video input interface receiving the digital video signal from the plurality of sources and identifying a video bitstream, wherein the video bitstream comprises video data based on a plurality of encoding methods corresponding to the plurality of sources;

a video decoding unit connected to the video input interface and decoding the video bitstream;

a video digital to analog converter connected to the video decoding unit and converting the video bitstream to an analog video signal;

a video output interface connected to the video digital to analog converter and distributing the analog video signal to the television; and

a synchronization unit connected to the audio output interface and the video output interface and synchronizing the analog audio signal and the analog video signal.

17. The system of claim 16, further comprising a splitter receiving a digital input signal and splitting the digital input signal into the digital audio signal and the digital video signal.

18. The system of claim 16 wherein the video input interface receives the digital video signal from a network.

19. The system of claim 16 wherein the video input interface receives the digital video signal from a local storage device.

20. The system of claim 19 wherein the video input interface receives the digital video signal produced by a digital video camera.

21. (Twice Amended) A method for distributing audio content of a digital audio signal to an analog wireline device, comprising the steps of:

receiving the digital audio signal from a plurality of sources and identifying an audio bitstream, wherein the audio bitstream comprises audio data based on a plurality of encoding methods corresponding to the plurality of sources;

decoding the audio bitstream;

converting the audio bitstream to an analog audio signal; and

distributing the analog audio signal to the analog wireline device.

22. The method of claim 21, further comprising the steps of decrypting the audio bitstream.

23. The method of claim 21, further comprising the steps of decrypting the analog audio signal.

24. The method of claim 21 wherein the step of decoding the audio bitstream includes decompressing the audio bitstream.

25. (Twice Amended) A method for distributing video content of a digital video signal to an analog wireline device, comprising the steps of:

receiving the digital video signal from a plurality of sources and identifying a video bitstream, wherein the video bitstream comprises video data based on a plurality of encoding methods corresponding to the plurality of sources;

decoding the video bitstream;

converting the video bitstream to an analog video signal; and

distributing the analog video signal to the analog wireline device.

26. The method of claim 25, further comprising the steps of decrypting the video bitstream.

27. The method of claim 25, further comprising the steps of decrypting the analog video signal.

28. The method of claim 25 wherein the step of decoding the video bitstream includes decompressing the video bitstream.

29. (Twice Amended) A method for distributing audio and video content of a digital audio signal and a digital video signal to an analog wireline device, comprising the steps of:

- receiving the digital audio signal from a plurality of sources and identifying an audio bitstream, wherein the audio bitstream comprises audio data based on a plurality of encoding methods corresponding to the plurality of sources;

- decoding the audio bitstream;

- converting the audio bitstream to an analog audio signal;

- receiving the digital video signal from a plurality of sources and identifying a video bitstream, wherein the video bitstream comprises video data based on a plurality of encoding methods corresponding to the plurality of sources;

- decoding the video bitstream;

- converting the video bitstream to an analog video signal; and

- distributing the analog audio signal and the analog video signal to the analog wireline device.

30. The method of claim 29, further comprising the steps of:

- receiving a digital input signal as an integrated digital input signal; and

- splitting the digital input signal into the digital audio signal and the digital video signal.